

86
and pearlescent agents, wherein the combination of the hydrophilic gelling agent and the cellulose derivative is present in the gel in an amount ranging from greater than 0% to 20% by weight, relative to the total weight of the gel.

REMARKS

I. Status of the Claims

Claims 27-83 are pending in the present application. Applicant gratefully acknowledges withdrawal of the Restriction Requirement. Upon indication of allowability of the elected species, Applicant expects the Examiner to continue the search and examination of the full scope of the claims, as required.

Claims 27, 47, 51, 60, 71, and 80-83 have been amended to more particularly describe that which Applicant considers to be the invention. Support for amended claim 27 can be found on pages 10-11 of the specification, for example. Support for amended claim 47 can be found on page 11 of the specification, for example. Support for amended claim 51 can be found on page 12 of the specification, for example. Support for amended claim 60 can be found on page 13 of the specification, for example. Support for amended claim 71 can be found on page 16 of the specification, for example. Support for amended claims 80 and 81 can be found in original claims 24 and 25 and on pages 17 and 18 of the specification, for example. Support for amended claims 82 and 83 can be found in original claims 24-26, for example. Accordingly, no new matter has been added by the forgoing amendments.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

II. Information Disclosure Statement

The Examiner appears to have not considered one of the references cited on the Information Disclosure Statement filed April 30, 2001. The Examiner provides no reason for his refusal to consider the reference. A copy of this reference was filed with the Information Disclosure Statement, as evidenced by a copy of the stamped postcard submitted herewith. However, for the Examiner's convenience, enclosed is another copy of this reference for his consideration. The reference in question was cited in the International Search Report of the PCT corresponding to this national phase application. The Examiner is kindly requested to signal his consideration of this reference by initialing the PTO-1449 and providing a copy to Applicant with the next communication.

III. Claim Interpretation

The Office Action provides a separate section entitled "Claim Interpretation." Office Action at pages 3-4. Applicant respectfully objects to the Examiner's "Claim Interpretation" section because there is no legal or procedural basis for such a section, especially as it is provided outside the context of an objection or rejection.

Applicant respectfully submits that claim 29 is proper, and that the Examiner has not alleged otherwise. The Examiner's Statement is without context.

The Examiner states that the terms "solid and gel have been defined at page 7, lines 6-17." The relevant passage on page 7 line 6 recites, "the expression solid gel is understood to mean...." Thus, the Examiner has pointed to one instance in the disclosure describing gel strength. However, the compositions throughout the

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

specification and claims also disclose gel strength. The Examiner's statement and further reference to MPEP § 2112 is without context.

IV. Claim Rejections - 35 USC § 112

The Examiner alleges that "several of the claims contain improper alternative groupings that should be corrected." Office Action at page 4. In particular, the Examiner notes that "and" is used several times in a single Markush group (e.g., claim 28). The Examiner's objection to the use of the term "and" is misplaced. The Examiner had not alleged with any specificity where lack of clarity exists in any of the elements or their combination in the Markush group of claim 28. Applicant respectfully submits that the alternative lists of elements in the Markush groups clearly define the metes and bounds of the claim.

The Examiner suggests that "applicants insert --the group consisting of-- after "chosen from." *Id.* Applicant respectfully declines the Examiner's suggestion, and submits the rejection is improper. The Examiner has shown no legal basis requiring a change to the claim language. Specifically, the Examiner relies on M.P.E.P. § 2173.05(h) for a discussion of proper alternative claim language. Yet, section 2173.05(h) (page 2100-202), merely recites examples of proper claim language ("one acceptable form of alternative claim language..."), which may be representative but are not exclusive. Thus, since the "chosen from" language clearly defines the metes and bounds of the Markush group, there is no legal basis to amend the claims.

The Examiner also alleges that "[s]everal of the claims employ the species as derivatives but fail to define how said materials are derived or what said materials

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

consist [of]. It is unclear what are the scope of the derivatives contemplated." *Id.* The Examiner's objection to the term "derivatives" is misplaced. The burden is on the Examiner to establish precisely why one of ordinary skill in the art would be unable to ascertain the metes and bounds of the claimed invention, and this burden has not been met by the conclusory statements in the Office Action.

In addition, according to MPEP § 2173.02, the claims must be considered in light of, *inter alia*, the teachings in the specification. In this case, the specification provides suitable non-limiting examples of certain derivatives at, e.g., page 8, lines 16-18. Thus, Applicant submits that this rejection is misplaced and is not in accord with proper PTO examination procedure.

The Examiner has rejected claims 54 and 55 because the phrase "metallic soaps" lacks antecedent basis. Office Action Page 5. Since this phrase is not found in claims 54 and 55, the rejection is clearly improper and should be withdrawn.

V. Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected claims 27-83 over WO 97/17055 (as represented by Roulier et al. U.S. 6,045,814 ("*Roulier*")) in view of Roulier et al. U.S. 6,280,750 ("*Roulier II*") for the reasons set forth on pages 5-8 of the Office Action, and separately rejects claims 27-83 over *Roulier* in view of Intercos Italia S.p.A. EP 0,803,245 A1 ("*EP '245*") for the reasons set forth on pages 8-9 of the Office Action.

Applicant respectfully submits that the §103 rejections are improper at least because (1) the Examiner neglected to identify the requisite motivation to combine the cited references, and (2) *Roulier II* does not qualify as a prior art.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

At the outset, and in view of the earlier priority date of the present application, Applicant notes that *Roulier II* is not available as a reference against the present claims. As such, Applicant requests that the rejection based upon *Roulier II* be withdrawn.

Roulier fails to teach or suggest the present claims at least because, as admitted by the Examiner, the presently claimed concentration of the gelling agent is lower than that disclosed in *Roulier*. Thus, *Roulier* teaches away from the present claimed invention. In general, references may not be combined where the references themselves teach away from their combination. MPEP 2143 X.D.2; *In re Grasselli*, 713 F.2d 731 (Fed. Cir. 1983). *Roulier* relates to compositions comprising at least one gelling agent in an amount of at least 20% by weight. The present claims recite *inter alia*, a solid aqueous gel wherein the combination of the hydrophilic gelling agent and the cellulose derivative is present in the gel in an amount ranging from greater than 0% to 20% by weight. The Office Action neglects to address, at least, this substantial discrepancy between the gelling agent concentration in the reference and that of the present claims.

EP '245 fails to remedy the deficiencies of *Roulier* at least because *EP '245* fails to establish the requisite motivation to provide the gelling agent of *Roulier* in an amount from greater than 0% to 20%. The Examiner asserts that gellan gum can be selected from a list of eight polysaccharides in *EP '245*. However, Applicant respectfully submits that (1) the Examiner has presented no line of reasoning as to why one of ordinary skill in the art would choose gellan gum from the laundry list provided in *EP '245*, and (2) there is no such suggestion or motivation provided by *EP '245* itself. Accordingly, Applicant submits that the Office has failed to provide specific reasoning for combining

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

the teachings of these documents. A convincing line of reasoning must be presented as to why one of ordinary skill in the art would pick and choose various elements and/or concepts from the prior art to arrive at the claimed invention. *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985); *In re Wesslau*, 147 USPQ 391 (Bd. Pat. App. & Inter. 1965).

In addition, Applicant respectfully submits that *EP '245* fails to disclose the use of a cellulose derivative, much less a cellulose derivative in combination with a hydrophilic gelling agent. Thus, the Office Action fails to identify the requisite clear and particular motivation in either of the cited references that would have directed one of ordinary skill to their combination. For at least this reason, this rejection should be withdrawn.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 

Brian M. Burn
Reg. No. 44,455

Dated: March 12, 2003

By: 

Harry J. Guttman
Reg. No. 51,762

Enclosures:

1. "Gelatin-free system for Soft/Hard Capsules Containing Gellan Gum," Research Disclosure, GB, Industrial Opportunities Ltd. Havant, No. 332, December 1, 1991.
2. Copy of stamped PTO postcard indicating fifteen documents were received.

APPENDIX - MARKED-UP VERSION OF THE AMENDED CLAIMS

27. (Once amended) A solid aqueous gel comprising: i) at least one hydrophilic gelling agent, ii) at least one cellulose derivative, and iii) a pulverulent phase comprising at least one component chosen from pigments and pearlescent agents, wherein the combination of the hydrophilic gelling agent and the cellulose derivative is present in the gel in an amount ranging [up] from greater than 0% to 20% by weight, relative to the total weight of the gel.

47. (Once amended) A gel according to claim 27, wherein at least one pigment is present in an amount ranging [up] from greater than 0% to 40% by weight, relative to the total weight of the gel.

51. (Once amended) A gel according to claim 27, wherein at least one pearlescent agent is present in an amount ranging [up] from greater than 0% to 40% by weight, relative to the total weight of the gel.

60. (Once amended) A gel according to claim 56, wherein the at least one filler is present in an amount ranging [up] from greater than 0% to 60% by weight, relative to the total weight of the gel.

71. (Once amended) A gel according to claim 69, wherein the water is present in an amount ranging [up] from greater than 0% to 99.8% by weight, relative to the total weight of the gel.

80. (Once amended) A make-up product for the skin or the keratinous fibres comprising a solid aqueous gel comprising: i) at least one hydrophilic gelling agent, ii) at least one cellulose derivative, and iii) a pulverulent phase comprising at

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

least one component chosen from pigments and pearlescent agents, wherein the combination of the hydrophilic gelling agent and the cellulose derivative is present in the gel in an amount ranging [up] from greater than 0% to 20% by weight, relative to the total weight of the gel.

81. (Once amended) A make-up product for the body, a foundation, an eyeshadow, a blusher, a concealer, a lipstick, a pencil for the contour of the lips, a mascara, a pencil for the contour of the eyes, a dyeing or make-up stick for locks of hair comprising a solid aqueous gel comprising: i) at least one hydrophilic gelling agent, ii) at least one cellulose derivative, and iii) a pulverulent phase comprising at least one component chosen from pigments and pearlescent agents, wherein the combination of the hydrophilic gelling agent and the cellulose derivative is present in the gel in an amount ranging [up] from greater than 0% to 20% by weight, relative to the total weight of the gel.

82. (Once amended) A method for applying make-up to the skin and/or the keratinous fibres, comprising applying to the skin and/or the keratinous fibres, a solid aqueous gel comprising: i) at least one hydrophilic gelling agent, ii) at least one cellulose derivative, and iii) a pulverulent phase comprising at least one component chosen from pigments and pearlescent agents, wherein the combination of the hydrophilic gelling agent and the cellulose derivative is present in the gel in an amount ranging [up] from greater than 0% to 20% by weight, relative to the total weight of the gel.

83. (Once amended) A method for applying make-up to the skin and/or the keratinous fibers, comprising applying to the skin and/or the keratinous fibres, a make-

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

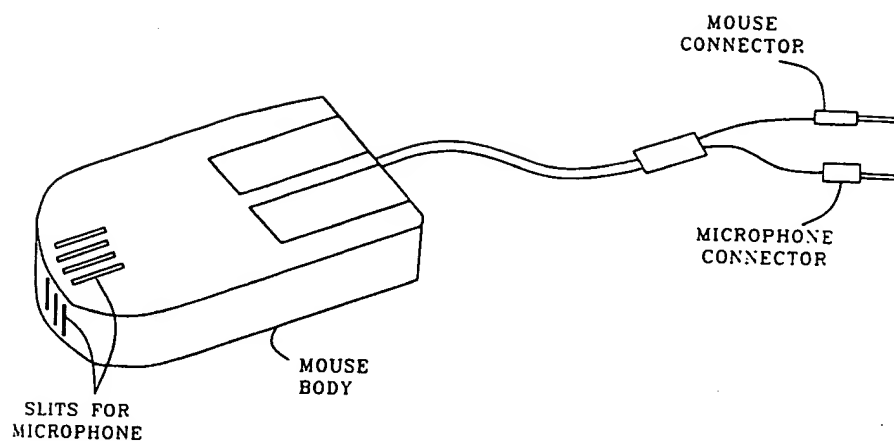
1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

up product for the skin or the keratinous fibres comprising a solid aqueous gel comprising: i) at least one hydrophilic gelling agent, ii) at least one cellulose derivative, and iii) a pulverulent phase comprising at least one component chosen from pigments and pearlescent agents, wherein the combination of the hydrophilic gelling agent and the cellulose derivative is present in the gel in an amount ranging [up] from greater than 0% to 20% by weight, relative to the total weight of the gel.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

ember 1991



Disclosed anonymously
33205

33206

Gelatin-free System for Soft/Hard Capsules Containing Gellan Gum

Disclosed is a composition that can replace gelatin in forming soft/hard capsules and encapsulating films. The major component is gellan gum which can be modified with various plasticizers, e.g. glycerol, sorbitol and polyethylene glycol, as well as other polymers, e.g. sodium carboxymethyl cellulose, to produce a range of flexible and elastic films or gels for encapsulation. A two percent slurry of gellan gum in deionized water is heated to 80 °C until the gum is completely solubilized and then the plasticizer and/or polymer(s) are added with agitation and the mixture is poured onto an aluminum plate. After drying overnight at 72°F and 60% RH, the film is removed from the plate and tensile tests are performed. An example would be 2.0 wt% gellan gum and 1.0 wt% sorbitol. The tensile strength at break of a thin film (1.5 mils) is 6388 psi and 20 % elongation. Using 2.0 wt% sorbitol produces a film of 3148 psi and a 40 % elongation at break. A 300 Bloom gelatin film with 20 wt% glycerol has a tensile strength at break of 4851 psi and a 36 % elongation. A film containing 2.0 wt% gellan gum and 1.0 wt% CMC 7L had a tensile strength of 13885 psi and a 5.2% elongation.

Disclosed by

Philip E. Winston Jr.
Kelco, Division of Merck & Co., Inc.
P.O. Box 23576
San Diego, CA 92193
33206